

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

MONOLITHIC POWER SYSTEMS, INC.,	No. C 08-4567 CW
Plaintiff,	ORDER CONCERNING
v.	DUTIES AND
O2 MICRO INTERNATIONAL LIMITED,	INSTRUCTIONS FOR
Defendant.	COURT-APPOINTED
	EXPERT DR. SETH
	SANDERS

The Court hereby appoints Dr. Sanders as its expert witness. See Fed. R. Evid. 706. As the court-appointed expert, Dr. Sanders shall serve as a neutral, independent expert on behalf of the Court on the technology at issue in this case. His duties shall be to provide expert analysis and opinions as to the technical issues in this case, including issues concerning infringement/non-infringement and validity/invalidity of the asserted claims of U.S. Patent Nos. 7,417,382 ("the '382 patent"), 6,856,519 ("the '519 patent"), 6,809,938 ("the '938 patent"), 6,900,993 ("the '993 patent"), and 7,120,035 ("the '035 patent") (collectively "the Patents-in-Suit"). These issues may include whether the accused products of any of the Counterclaim-Defendants have infringed any of the Patents-in-Suit literally or under the doctrine of

1 equivalents and/or whether any of the Patents-in-Suit is invalid in  
2 view of the prior art by reason of anticipation or obviousness.  
3 Dr. Sanders' duties may also include providing expert analysis and  
4 opinions on claim construction issues related to asserted claims of  
5 the Patents-in-Suit.

6 Dr. Sanders will be provided with various materials to use as  
7 resources when forming his opinions. He is not limited to these  
8 materials, and may request additional information if he believes  
9 that it is necessary. He may give these materials as much weight  
10 and consideration as he believes in his professional judgment is  
11 required.

12 Copies of the following materials will be provided to Dr.  
13 Sanders within five days of the entry of this order, in organized  
14 binders that are labeled and tabbed:

- 15 (i) the model jury instructions for patent cases in the
- 16 Northern District of California;
- 17 (ii) all Patents-in-Suit;
- 18 (iii) the file histories of all Patents-in-Suit;
- 19 (iv) O2 Micro's Infringement Contentions;
- 20 (v) all product materials cited in O2 Micro's Infringement
- 21 Contentions;
- 22 (vi) each Counterclaim-Defendant's invalidity contentions;
- 23 (vii) the prior art references cited in each
- 24 Counterclaim-Defendant's invalidity contentions;
- 25 (viii) Monolithic Power Systems, Inc.'s ("MPS") Second Amended
- 26 Complaint;
- 27 (ix) O2 Micro's First Amended Answer and Counterclaims; and
- 28 (x) each Counterclaim-Defendant's responsive pleading to O2

Micro's First Amended Answer and Counterclaims.

The parties will provide additional materials to Dr Sanders during the course of the litigation. Those materials will include the following:

- (i) O2 Micro's answer and counterclaims to MPS's Second Amended Complaint on or about the same day it is filed;
- (ii) Each Counterclaim-Defendant's responsive pleading to O2 Micro's answer and counterclaims on or about the same day the responsive pleading is filed;
- (iii) The expert reports on infringement/non-infringement and validity/invalidity exchanged in the ITC proceeding (Investigation No. 337-TA-666), on or before July 31, 2009;
- (iv) The expert reports on infringement/non-infringement and validity/invalidity exchanged by the parties in this case, on or before August 17, 2009;
- (v) The parties' Joint Claim Construction and Prehearing Statement on or about June 26, 2009.

The parties will send the documents to Dr. Sanders jointly. If the parties disagree about the propriety of providing a certain document or thing to Dr. Sanders, the parties will seek the Court's assistance and neither party shall provide that document or thing to Dr. Sanders unless and until the Court has resolved the issue.

Among other things, Dr. Sanders may look to the reports and the deposition transcripts of the parties' experts for guidance as to what the experts and the parties believe are the key issues to be addressed in this case. However, it is not his role to critique the parties' experts. His opinions are to be his own independent

1 opinions.

2 Dr. Sanders should follow the basic rules of patent law as set  
3 forth in the model jury instructions for patent cases in the  
4 Northern District of California, including the requirement that he  
5 must follow prior court orders interpreting the meaning of certain  
6 patent claim terms. He is not required to provide a detailed  
7 analysis of patent law. If Dr. Sanders requires further guidance  
8 regarding patent law terminology, or the relevant legal standards,  
9 he can direct inquiries to the parties or the Court with respect  
10 thereto, as described below.

11 After reviewing the materials provided to him, and conducting  
12 his own independent analysis, Dr. Sanders will prepare an expert  
13 report, containing a statement of his opinions and the reasons for  
14 his opinions. Dr. Sanders may want to attach the claim charts  
15 described below as exhibits to his report. The Court and the  
16 parties are looking for a basic statement of Dr. Sanders' opinions  
17 in this case. Although he may look to other expert reports for  
18 guidance as to formatting and standard content, no specific format  
19 is required. His report should be sent to the parties by express  
20 mail no later than August 31, 2009, or another date prior to  
21 November, 2009 to be agreed upon by Dr. Sanders and the parties.

22 In his expert report:

23 (i) Dr. Sanders will offer his opinion on infringement by  
24 determining whether each and every element of the  
25 asserted claims can be found in  
26 Counterclaim-Defendants' accused products. 02 Micro's  
27 infringement contention chart should set out its  
28 infringement theory on an element-by-element basis.

1 Similarly, the parties' expert reports should track  
2 this element-by-element analysis, including  
3 Counterclaim-Defendants' responses to O2 Micro's  
4 infringement claim. Dr. Sanders should conduct his own  
5 independent analysis in the same manner as the parties  
6 in this case. The parties will provide him with blank  
7 versions of these claim charts in electronic format for  
8 his convenience.

9 (ii) Dr. Sanders will offer his opinion on patent invalidity  
10 due to anticipation by determining whether or not each  
11 and every element of one or more of the asserted claims  
12 can be found in any one item of prior art.

13 Counterclaim-Defendants' invalidity contention charts  
14 should set out their invalidity-due-to-anticipation  
15 theories on an element-by-element basis. Similarly,  
16 the parties' expert reports should track this  
17 element-by-element analysis, including O2 Micro's  
18 response to Counterclaim-Defendant's anticipation  
19 claim. Dr. Sanders should conduct his own independent  
20 analysis on anticipation in the same manner as the  
21 parties in this case. The parties will provide him  
22 with blank versions of these claim charts in electronic  
23 format for his convenience.

24 (iii) Additionally, Dr. Sanders will offer his opinion on  
25 invalidity due to obviousness by determining whether or  
26 not it would have been obvious to combine the teachings  
27 of certain references to achieve the claimed invention.  
28 Counterclaim-Defendants' invalidity contention charts

1           should set out their invalidity-due-to-obviousness  
2           theories on an element-by-element basis. Similarly,  
3           the parties' expert reports should track this  
4           element-by-element analysis, including O2 Micro's  
5           response to Counterclaim-Defendants' obviousness claim.  
6           Dr. Sanders should conduct his own independent analysis  
7           on obviousness in the same manner as the parties in  
8           this case. The parties will provide him with blank  
9           versions of these claim charts in electronic format for  
10          his convenience.

11          The parties will depose Dr. Sanders on or before September 7,  
12   2009 (or another date prior to November, 2009 to be agreed upon by  
13   Dr. Sanders and the parties) at a location that is convenient to  
14   him. At the deposition, the parties may ask him questions, and he  
15   will be given the opportunity to explain his opinions in greater  
16   detail prior to his testimony at trial. Each party may depose Dr.  
17   Sanders for up to 3.5 hours.

18          The Court may require Dr. Sanders to attend the claim  
19   construction oral hearing on December 10, 2009. If this is the  
20   case, Dr. Sanders shall review the parties' claim construction  
21   briefs prior to the hearing. Additionally, Dr. Sanders shall  
22   provide the Court and the parties with his advisory opinion on  
23   claim construction on or before November 30, 2009. The advisory  
24   opinion shall include Dr. Sanders' proposed constructions of the  
25   disputed claim terms and his reasoning for arriving at those  
26   constructions.

27          If the Court's claim construction order causes Dr. Sanders to  
28   change any opinions rendered in his expert report, he should so

1 indicate in a supplemental report to be sent within 14 days of the  
2 issuance of the Court's claim construction order, in which case the  
3 parties will be permitted to depose him on those issues.

4 Lastly, Dr. Sanders will testify at trial on his opinions.  
5 Dr. Sanders will testify after the parties' experts, and thus will  
6 not be required to give a lengthy tutorial on the technology at  
7 issue to the jury. The trial is scheduled to begin on August 2,  
8 2010, and will continue for two weeks. The Court and the parties  
9 will attempt to accommodate Dr. Sanders' schedule and to give him  
10 as much advance notice as possible as to what day (or days) he will  
11 be needed to testify. Trials are complex matters, however,  
12 involving many witnesses, so flexibility will be required. The  
13 parties will pay for all of Dr. Sanders' reasonable hotel and  
14 travel expenses.

15 Dr. Sanders may contact the Court by calling its clerk at  
16 (510) 637-3542 if questions come up or if he encounters difficulty  
17 in accomplishing his assigned tasks. The clerk will arrange a  
18 conference call with the attorneys. He may also contact the Court  
19 by letter, with a carbon copy to the parties, or by emailing the  
20 clerk and "cc"-ing the parties. The clerk's email address is  
21 "sheilah\_cahill@cand.uscourts.gov." In addition, Dr. Sanders may  
22 contact the parties directly, by using the e-mail addresses that  
23 they will provide to him, if he needs additional documents or other  
24 information. Dr. Sanders, however, shall not contact only one  
25 party, as it is important that both sides be given the chance to  
26 communicate with him jointly if needed. The parties will set up a  
27 conference call if necessary.

28 Dr. Sanders must confirm that he has no conflict of interest.

1 Specifically, Dr. Sanders should mail to the Court the information  
2 requested in the attached "Disclosure Form."

3 O2 Micro shall pay for half of Dr. Sanders' fees and expenses,  
4 and the Counterclaim-Defendants will share equally the other half.  
5 O2 Micro will deposit a retainer of \$20,000 in the Howrey trust  
6 account, and Counterclaim-Defendants will deposit a retainer of  
7 \$20,000 in the Latham & Watkins trust account. Dr. Sanders may  
8 bill at his usual hourly rate or at an agreed rate commensurate  
9 with the rates paid to the parties' expert witnesses.

10 IT IS SO ORDERED.

11  
12 Dated: 5/22/09



13 CLAUDIA WILKEN  
14 United States District Judge  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



UNITED STATES DISTRICT COURT  
FOR THE  
NORTHERN DISTRICT OF CALIFORNIA

MONOLITHIC POWER SYSTEMS, INC. et al,

Case Number: CV08-04567 CW

Plaintiff,

**CERTIFICATE OF SERVICE**

v.

O2MICRO INTERNATIONAL LIMITED et al,

Defendant.

I, the undersigned, hereby certify that I am an employee in the Office of the Clerk, U.S. District Court, Northern District of California.

That on May 22, 2009, I SERVED a true and correct copy(ies) of the attached, by placing said copy(ies) in a postage paid envelope addressed to the person(s) hereinafter listed, by depositing said envelope in the U.S. Mail, or by placing said copy(ies) into an inter-office delivery receptacle located in the Clerk's office.

Dr. Seth Sanders  
Department of EESC  
565 Cory Hall  
University of California  
Berkeley, CA 94720

Dated: May 22, 2009

Richard W. Wieking, Clerk  
By: Sheilah Cahill, Deputy Clerk

United States District Court  
For the Northern District of California